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09/704,262	11/01/2000	Robert S. Philips	48452-049	3550

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Proskauer Rose LLP
Patent Department
1585 Broadway
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EXAMINER

EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/704,262

Applicant(s)

PHILIPS ET AL.

Examiner

Bradley Edelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-164 is/are pending in the application.
4a) Of the above claim(s) 67-73, 140-146, 153-155 and 162-164 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-66, 74-139, 147-152 and 156-161 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 01 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 13 pages.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to Applicant's response received on March 3, 2005 to the restriction requirement sent on January 26, 2005. Applicant has elected claims 1-66, 74-139, 147-152, and 156-161. Claims 67-73, 140-146, 153-155, and 162-164 are withdrawn from consideration.

Specification

1. The specification is objected to for the following reasons.
 - a. The abstract of the disclosure is objected to because it is longer than 150 words. Correction is required. See MPEP § 608.01(b).
 - b. The disclosure is objected to because of the following informalities: the status of the cases listed on page 1 need to be updated.

Appropriate correction is required.

Claim Objections

2. Claim 2 is objected to because of the following informalities: line 2 of the claim contains a grammatical error. It appears that the phrase "of that at least a part" should read "that at least a part." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-66, 74-139, 147-152, and 156-161 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In considering independent claims 1, 41, 74, and 114, each of these claims includes two phrases that make the claims ambiguous. First, the claims describe a "user group of one or more users." See, e.g., claim 1, line 2. This is ambiguous because it suggests that a group can consist of a single user, but the claims later suggest that a group must consist of more than one user. See, e.g., claim 1, line 7, which states "permitting more than one user of the pre-subscribed user group to access the file group at the remote file server node simultaneously." Thus, it is not clear whether a user group may consist of only one user or multiple users.

Second, the claims all describe "the files of the file group." See, e.g., claim 1, lines 5-6. This phrase lacks antecedent basis because the claim does not describe any files or any file groups prior to referring to "the files of the file group."

In further considering claim 34, the claim contains a grammatical error that renders the claim ambiguous. Lines 2-3 of the claim state "transferring an encrypted key from the remote file server node to a particular client nodes." Claims 60, 107, and 133 contain the same ambiguous limitation. Claims 35, 61, 108, and 134 depend from claims 34, 60, 107, and 133 respectively and are rejected for the same reasons.

In further considering claim 138, the claim depends from itself and therefore lacks sufficient antecedent basis.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 7-41, 47-66, 74, 80-114, 120-139, 147-152, and 156-161 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over respective claims 1-131 of copending Application No. 09/703,884. Although the conflicting claims are not identical, they are not patentably distinct from each other, for the reasons stated as follows.

Present Application

Application 09/703,884

Claim 1	Claim 1
1. A method for providing multi-user file storage comprising the steps of:	1. A method for providing multi-user file storage comprising the steps of:
(a) enabling each user of a pre-subscribed user group of one or more users to <u>connect</u> an arbitrary client node at an	(a) enabling each user of a pre-subscribed user group of one or more users to <u>operate</u> an arbitrary client node at an

arbitrary geographic location to a remote file server node via a wide area network,	arbitrary geographic location to <u>communicate with</u> a remote file server node via a wide area network,
(b) enabling each user of the pre-subscribed user group to access the files of the file group via the respective client node <u>connected to</u> the remote file server node via the wide area network, including permitting more than one user of the pre-subscribed user group to access the file group at the remote file server node simultaneously,	(b) enabling each user of the pre-subscribed user group to access the files of the file group via the respective client node in <u>communication with</u> the remote file server node via the wide area network, including permitting more than one user of the pre-subscribed user group to access the file group at the remote file server node simultaneously, <u>and</u>
(c) maintaining the integrity of the files at the remote file server node by controlling each access to each of the files at the remote file server node so that each access to each the files at the remote file server is performed, if at all, on a respective portion of the respective file as most recently updated at the remote file server node, thereby enabling all native operating system application programming	(c) maintaining the integrity of the files at the remote file server node by controlling each access to each of the files at the remote file server node so that each access to each the files at the remote file server is performed, if at all, on a respective portion of the respective file as most recently updated at the remote file server node, thereby enabling all native operating system application programming

interfaces to operate so that all multi-user applications accessing the files function as if the remote server, which stores the files, and client nodes, at which such multi-user applications execute, were on the same local area network, <u>and</u>	interfaces to operate so that all multi-user applications accessing the files function as if the remote server, which stores the files, and client nodes, at which such multi-user applications execute, were on the same local area network.
<u>(d) delegating version control of a particular one of the files to a version control node.</u>	

The claims of the '884 application anticipate all of the limitations of the claims of the present application. The terms "connect to" and "in communication with" have the same meaning in the context of the claim. Further the added limitation in the present application of "delegating version control of a particular one of the files to a version control node" will necessarily occur in the system claimed in the '884 application because the claims describe version control (i.e. maintaining integrity based on most recently updated portions of the file), and so a node will necessarily have to perform the version control of that file.

Claim 1 of the present application is thus not patentably distinct from claim 1 of the '884 patent application and as such is unpatentable for obvious-type double patenting.

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Independent claims 41, 74, and 114 are likewise anticipated by respective claims 36, 59, and 94 of the '884 application and are therefore rejected under obvious-type double patenting for the same reasons.

Dependent claims 7-40, 47-66, 80-113, 120-139, 147-152, and 156-161 are identical to respective dependent claims 2-35, 37-56, 60-93, 95-114, 117-122, and 126-131 of the '884 application and are therefore rejected under obvious-type double patenting for the same reasons.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 7-10, 13-18, 20-23, 33, 38, 40-43, 47-49, 59, 64, 66, 74-76, 80-83, 86-91, 93-96, 111, 113, 114-116, 120-122, 132, 137, and 139 are rejected under 35

U.S.C. 102(e) as being anticipated by Brown et al. (U.S. Patent No. 6,067,551, hereinafter "Brown").

In considering claim 1, as understood, Brown discloses the claimed method for providing multi-user file storage comprising the claimed steps of:

- (a) enabling each user of a group of clients to connect to an arbitrary client node at an arbitrary location to a remote file server ("file server 20") via a wide area network ("Internet");
- (b) enabling each user to access the files on the server, including permitting simultaneous access to the files ("simultaneous, multi-user editing") by users;
- (c) maintaining file integrity by controlling access to files so that access is performed on respective portions of a respective file as most recently updated at the remote file server node ("latest versions of the master copy"), so that all native operating system APIs operate so that all multi-user applications function as if they were on the same local area network (i.e. it doesn't matter whether they're communicating over the Internet or LAN – they still have the same access to files); and
- (d) delegating version control of a particular one of the files to a version control node ("MCF" controls the versions and resides at the server).

See col. 9, line 55 – col. 11, line 51 describing these features.

Claims 2, 3, 7-10, 13-18, 20-23, 33, 38, 40, 41-43, 47-49, 59, 64, and 66 are disclosed by Brown as well. See also, col. 11, lines 1-3 describing overwriting; col. 17, lines 1-7 describing storing incremental changes; col. 14, line 43 – col. 15, line 45

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describing conflict resolution; col. 12, lines 17-35 describing closing and re-opening a communication.

Claims 74-76, 80-83, 86-91, 93-96, 111, 113, 114-116, 120-122, 132, 137, and 139 present a system for performing the method steps described in respective claims 2, 3, 7-10, 13-18, 20-23, 38, 40, 41-43, 47-49, 59, 64, and 66 and are rejected for the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11, 19, 84, and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, in view of Howard (U.S. Patent No. 5,600,834).

In considering claims 11, 19, 84, and 92, these claims require that if a user designates, then the system should automatically download changes made to the file so that the client node is automatically updated. This feature is not taught by Brown, but it is well known in the art, as evidenced by Howard. Howard teaches a similar art system for reconciling different versions of files between computers, wherein changes to files are automatically sent to other computers in the system (see cols. 1-2). Given this knowledge, it would have been obvious to automatically send file changes to the clients

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in the system taught by Brown, so that clients could be kept up-to-date regarding the status of network files.

7. Claims 27-29, 31, 32, 53-55, 57, 58, 100-102, 104, 105, 126-128, 130, and 131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, in view of Shimbo et al. (U.S. Patent No. 5,835,601, hereinafter "Shimbo").

In considering claims 27-29, 31, 32, 53-55, 57, 58, 100-102, 104, 105, 126-128, 130, and 131, Brown does not discuss encryption and authentication aspects of the file sharing system. Nonetheless, it is well known for file sharing systems such as the one taught by Brown to use authentication and encryption features in order to secure data access to clients and servers in the system, as evidenced by Shimbo. In a similar art, Shimbo discloses a file sharing and editing system for controlling access by clients to shared files stored at a server, including the authentication steps and encryption and decryption steps claimed in claims 27-29, 31, 32, 53-55, 57, 58, 100-102, 104, 105, 126-128, 130, and 131 (see Shimbo, at least cols. 5, 15-17). Given this teaching, it would have been obvious to include any of the known security measures taught by Shimbo in the file sharing system taught by Brown, to increase security of the system.

8. Claims 36, 62, 109, 135, 147-152, and 156-161 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, in view of what was commonly known in the art at the time the invention was made.

In considering claims 36, 62, 109, and 135, these claims describe compressing the file information prior to uploading and decompressing the information subsequent to downloading. Although Brown does not discuss compression and decompression, Examiner takes official notice that it was well known in the art at the time the invention was made to compress information sent across a network and decompress the information after receipt. Compression and decompression of such network data is widely used as a method for decreasing network traffic. Therefore, it would have been obvious to include that feature in the system taught by Brown, to decrease network traffic over the Internet.

In considering claims 147-152 and 156-161, these claims all describe the system as a wireless system and the client as a remote device. Although this configuration is not taught by Brown, Examiner takes official notice that connecting to the Internet via a wireless connection on a remote device was well known at the time the invention was made. Therefore, it would have been obvious to include wireless devices in the system taught by Brown, so that users needn't connect their computers to bulky wires at specified locations.

9. Claims 12 and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown.

In considering claims 12 and 85, Brown further discloses that if the particular client stops editing the file without closing the file, then relinquishing the particular file at

the server node and allowing other client nodes to access the file (col. 16, lines 24-43).

Brown does not explicitly teach that the client stops editing the file because the connection has closed. Nonetheless, Brown does disclose that users could become disconnected (col. 15, lines 49-65). Therefore, one of the ways for a user to end editing a file is by disconnecting from the server and it would have been obvious to relinquish the file and permit others to access it upon such disconnection, since the user is no longer able to change the file.

10. Claims 24, 39, 50, 65, 97, 112, 123, and 138 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, in view of Vahalia et al. (U.S. Patent No. 6,192,408, hereinafter "Vahalia").

In considering claims 24, 50, 97, and 123, Brown does not disclose providing access to the file through an intermediate node as claimed. Nonetheless, such access is well-known, as evidenced by Vahalia. In a similar art, Vahalia discloses a system for sharing files and file access between a server and multiple clients, wherein the system employs intermediate nodes to coordinate such access (Fig. 7; cols. 1-2). It would have been obvious to use such a system for the file sharing system taught by Brown to decrease load on the server of Brown.

In considering claims 39, 65, 112, and 138, Vahalia further discloses selecting a server based on load-balancing techniques (cols. 12-13; Fig. 7). Given such knowledge, it would have been obvious to a person having ordinary skill in the art to

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include such load balancing in the system taught by Brown, to increase data availability and avoid bottlenecks.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 571-272-3953. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached at 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bradley Edelman

BE
May 16, 2005